

REMARKS

Reconsideration of the application is respectfully requested for the following reasons:

1. Rejection of Claims 3 and 6 Under 35 USC §112, 2nd Paragraph

This rejection has been addressed by amending claims 3 and 6 to recite the –wireless command signal– rather than the “remote control signal,” thereby correcting the antecedence error noted on page 2 of the Official Action.

It is respectfully submitted that because the amendments to the claims merely correct antecedence errors, the amendments do not raise new issues that would require further consideration or a new search, and therefore that entry of the amendments is appropriate under 37 CFR §1.116.

2. Rejection of Claims 1-17 Under 35 USC §103(a) in view of U.S. Patent Nos. 6,203,395 (McElhaney) and 6,113,455 (Whelan), and the Publication Entitled “Kick Start Busy Crib Center” (the Kick Start Publication)

This rejection is again respectfully traversed on the grounds that none of the three references applied in this rejection discloses or suggests the claimed **combination** of a **crib mobile** with a **kick-bar activated remote control**, as recited in claims 1 and 8, much less the combination of a crib mobile with two remote control units, one of which is a kick-bar unit, as recited in claims 3-6, 11, 12, and 14-17.

In the previous Response, it was pointed out that:

- a. the kick-bar unit of McElhaney does not include any sort of transmitter, and does not serve to activate a mobile, much less remotely activate the mobile;
- b. the Whelan patent teaches a transmitter, but the transmitter is part of a baby monitoring unit and is remotely activated only by parents; and
- c. the Kick Start Publication fails to teach any sort of kick-bar or transmitter.

In reply, the Examiner notes that teachings of a combination do not have to be express, justifying the combination of Whelan and McElhaney by stating that “*the McElhaney reference was combined with the Whelan et al. reference merely to teach the concept of using a second remote control unit in addition to the kicking unit allowing a remote user, such as a parent to activate the mobile,*” and that the combination would have obvious because the combination provides increased “entertainment value” relative to the toys disclosed in the references.

While the Applicant completely agrees that teachings do not have to be express to justify a combination, the Applicant disagrees that the overall teachings of the references may be ignored in order to justify the combination, or that the advantages of the combination itself may be used to justify a rejection irrespective of whether the advantages of the combination are apparent from the references. The Applicant’s position continues to be that:

- a. **None** of the references teaches remote activation of a mobile by a baby;
- b. **None** of the references teaches remote activation of any sort of device by a baby;
- c. As a result, **none** of the references teaches or suggests, whether explicitly or implicitly, that addition of a transmitter to a kickbar, so that a baby can activate a mobile, provides increased entertainment value; and
- d. To the contrary, the fact that teachings do not need to be express to justify a combination is not a license to ignore the actual teachings of the references, or to justify the combination based on the advantages of the combination (*i.e.*, that the combination provides increased entertainment value).

It is not, as suggested by the Examiner, permissible to ignore the actual teachings of a reference in order to justify a combination. The ordinary artisan would not have had the template used by the Examiner to ignore certain teachings in the references while expanding others to come up with the claimed combination. As explained in MPEP 2141.02, p. 2100-107: **A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention** (emphasis in the original)

One cannot reasonably say that Whalen suggests modification of the non-remote kick-bar unit of McElhaney to add a transmitter without considering that Whalen teaches a parent operated remote that would never be located in a kick-bar, and that McElhaney is concerned with kick-bar activation of a non-remote activity center.

This is what Whalen actually teaches concerning remote control of a mobile (col. 6, lines 9-15:

. . . It should be noted that the portable module also includes a music button, a light button, a mobile button, and a timer button similar to those set forth hereinabove. Further, a power button and a radio channel/band selector may be included, as shown in FIG. 2. The control panel is preferably equipped with a receiver in order to allow remote control of the various features of the frame by these buttons.

Nowhere in this passage, or any other passage in the Whalen patent, is there a teaching that the transmitter should or could be moved from a portable module operable by a parent to the crib in which the mobile is situated, much less in a way that permits the baby to remotely activate the mobile. The purpose of the transmitter is very clearly to permit a parent to activate the mobile. Neither Whalen nor McElhaney even remotely suggests that the entertainment value of a mobile would be increased if the baby, rather than just the parent, could remotely activate it.

Furthermore, Whalen does not, as suggested by the Examiner, teach a “second” transmitter for operating a mobile, as recited in claim 14. The “first” transmitter in Whalen has an entirely different function than the “second” transmitter, namely to transmit signals from a microphone 44 situated on the cross bar of the mobile to the portable module so that the baby’s sounds can be monitored. This cannot reasonably be said to be suggestive of providing two transmitters to activate a mobile, as claimed. The second transmitter of Whalen is on the mobile itself, and transmits signals to the remote control—not the other way around.

The sole motivation for the combination continues to be that the combination improves “the entertainment value of the crib toy.” The motivation is not based on any advantages of the toys disclosed in the references, but rather on the advantages of the combination, which is taught

only in Applicant's own specification. Certainly, it is obvious *in hindsight* that a kickbar activated mobile provides increased entertainment value (as well as increased "educational" value since it teaches the baby about cause and effect). However, the McElhaney patent certainly does not disclose or suggest that adding a transmitter to the kickbar would add to its entertainment value. If McElhaney had known that adding a transmitter would add to its entertainment value, he would have done so.

Similarly, the Whalen patent does not disclose or suggest that adding a transmitter to a kick bar would add to its entertainment value. The transmitter of Whalen does not add to the entertainment value of the mobile, but merely enables a parent to turn it on and off from across the room, for the convenience of the parent. The Kick Start publication also does not disclose or suggest that adding a transmitter to a kick bar would add to its entertainment value since the publication does not concern a transmitter or kick bar. Therefore, the motivation of increasing entertainment value could only have come from the teachings of the Applicant, adopted in hindsight by the Examiner. Without that hindsight, the ordinary artisan motivated by the teachings of McElhaney, Whalen, and Kick Start to add a transmitter to the kickbar of McElhaney so as to permit the baby, as opposed to its parents, to activate a mobile. The fact that adding the transmitter turns out to be a good idea is not an indication that the addition would have been obvious.

Using the advantages of a combination to justify a rejection is classic hindsight. Under this "reasoning," all combinations are obvious if they have advantages. Only non-advantageous combinations can possibly be patentable. Even though a combination is not disclosed or suggested in the references, and the advantages of the combination are not possessed by any of the devices being combined, the combination is, according to the Examiner, obvious solely because the prior devices *could* be combined, and because the *combination* has advantages.

Under the Examiner's reasoning, the Wright Brother's patent on aircraft control would have been considered obvious because birds and insect warp their wings in a similar manner, and

because warping of the wings to allow turning of an airplane offers the advantage of easier airplane control (even though no one had previously thought of using the wing warping of an insect in a man-made heavier-than-air craft). Similarly, Morse's telegraph would have been considered obvious by the Examiner because wires and electrical signals *could* have been combined to send dots and dashes, and because the *combination* has the advantage of permitting remote communications. The rejection of the present invention uses exactly the same reasoning. Because one *could* place a parent-activated transmitter into a kickbar, and even though no reference suggests doing so, because the result of the combination is to "improve the entertainment value of the crib toy," the combination must be obvious. Moreover, any suggestions to the contrary in the references themselves are simply dismissed by the Examiner on the grounds that the references were not cited for their contrary teachings.

The fact is that the prior art only teaches the following:

	McElhaney	Whalen	Kick Start	Claimed
Kick-Bar	Yes, but no remote	No	No	Yes, activates remote
Transmitter in Kickbar	No	Transmitter for parents—nothing to do with kick bar and <u>no</u> suggestion that combination with a kickbar would improve entertainment value	No	Yes, so that baby can remotely activate mobile

Logically, if three references do not disclose or suggest adding a transmitter to a kickbar, they could not possibly have suggested the *advantages* of doing so. **None** of the references teaches or suggests modification of the entertainment center of McElhaney to include a kick bar activated remote control for activating a mobile, and **none** suggests any sort of baby-activated remote control. Yes, the result of the combination is improved entertainment value for the baby, but this is an advantage of the *combination*, and not a teaching or suggestion of any of the

references. The fact that a combination has advantages not recognized in the prior art is logically an indication of non-obviousness rather than obviousness.

The reason that the claimed combination is more entertaining is that the combination that any of the prior art baby toys is that it gives the infant control over the activation of a remotely located device. The McElhaney patent does not give an infant remote control over the activation of a remotely located device, but only allows a baby to directly activate a crib toy. The applicant is not claiming direct activation of a crib toy by a kick bar. Furthermore, the Whelan patent does not give the infant control over a remotely located device, but rather gives parents control. The Kick Start publication does not include any sort of remote control.

It is of course well-known to provide different types of devices with remote controls that can be operated by non-infants. However, none of the references of record discloses or suggests any sort of remote control device, and particularly one for a crib mobile, that can be operated by infants. From the infant's point of view, the ability to remotely activate objects is a major advance, never before accomplished or even suggested in the history of baby toys. Yes, this is an advantage, but the fact that it is advantageous is not, as alleged by the Examiner, an indication of obviousness. The claimed combination, suggested only by the Inventor, gives infants powers that go way beyond the power provided by the kick-bar of McElhaney, since it permits the infant to operate a device that is unconnected, from the infant's point-of-view, to the kick-bar. The parent-operated remote control of Whelan of course gives no such power to the infant. **No toy, in the history of baby toys, has ever given an immobile infant the power of remote control, i.e., the power to activate a mobile situated above the infant's crib without the assistance of parents.** Remote controls have been known for a long time, as have crib mobiles, and their combination is known from the Whelan patent. But Whelan does not suggest the further step provided by the invention, namely making the remote control accessible to an immobile baby. Only Applicant's specification suggests doing so.

Again, the Examiner is reminded that it is improper to base a rejection on the advantages of a combination that is not itself suggested by any of the references. As explained, for example, in, *In re Fritch*, 23 USPQ2d 1780,1783 (Fed. Cir. 1992):

'Obviousness cannot be established by combining the teachings of the prior art to produce the claimed invention, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined only if there is some suggestion or incentive to do so [quoting ACS Hosp. Systems, Inc. v. Montefiore Hosp., 221 USPQ 929,933 (Fed. Cir. 1984)].' Although couched in terms of combining teachings found in the prior art, the same inquiry must be carried out in the context of a purported obvious 'modification' of the prior art. The mere fact that the prior art may be modified in the manner suggested by the Examiner does not make the modification obvious unless the prior art suggested the desirability of the modification [emphasis added].

It is respectfully submitted that while the elements of the claimed combination were known and *could* have been combined to obtain an infant-activated remote control, the mere fact that the combination is advantageous is not a proper ground for rejection, and withdrawal of the rejection of claims 1-17 under 35 USC §103(a) is requested.

Having thus overcome each of the rejections made in the Official Action, withdrawal of the rejections and expedited passage of the application to issue is requested.

Respectfully submitted,

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Date: February 18, 2004

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